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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/553,560	10/13/2006	John Waterfield	220069.401USPC	1844
500	7590	11/17/2008	EXAMINER	
SEED INTELLECTUAL PROPERTY LAW GROUP PLLC			PARKER, FREDERICK JOHN	
701 FIFTH AVE			ART UNIT	PAPER NUMBER
SUITE 5400			1792	
SEATTLE, WA 98104				

  

MAIL DATE	DELIVERY MODE
11/17/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/553,560	WATERFIELD, JOHN	
	<b>Examiner</b>	<b>Art Unit</b>	
	Frederick J. Parker	1792	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 02 October 2008.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-4 and 8-18 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-4,8-18 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____ .	6) <input type="checkbox"/> Other: _____ .

## **DETAILED ACTION**

### *Response to Amendment*

#### *Claim Rejections - 35 USC § 103*

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
  
2. Claims 1-4, 8-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schafer WO 97/09179 in view of the APA and Colton et al US2002/0132871.

Schafer teaches an improved measuring device/ ruler in which a transparent material, especially acrylic, is screen printed with thick lines to form multi-colored gradations which form the measuring units in at least one stage (pages 1,2,7,8 and elsewhere). The printing of “UV cured inks per claim 4 is taught (page 3, top). While non-slip characteristics is not cited, the APA states on page 1 that it is known and conventional in the art that solvent-based coatings having non-slip characteristics which are imparted by additions of a filler such as fine sand or pumice are printed onto the rulers after scalar markings have been applied. The coatings include, but are not limited to, an ink, adhesive, and varnish which may contain fine granular sand, pumice, etc per claims 3, 12,15,17,18. Given such knowledge known in the art, one of ordinary skill would have looked for specific slip resistant coatings to apply to the device/ ruler of Schafer, and therefore have looked to Colton et al for a specific UV curable composition known to provide a permanent clear (thus not impeding viewing of the item measured nor the scalar markings beneath; claims 1,8,9,13) coat which protects underlying surfaces from scratching, abrading (= snag resistant), etc [0016] and may further incorporate particulate (=granular) of quartz

(encompassing sand), alumina, etc [0074]. The coatings are rapidly UV curable, “normally in seconds” and with minimal heat [0019]. Photo-initiators are cited [abstract and elsewhere]. While specific temperatures are not cited, the times of Colton are in the range of “within 30 seconds’ so one would have expected similar minimal temperatures. Furthermore, it is the Examiner’s position that curing time/ temperatures which are well-known cause-effective variables, would have been dictated by a variety of ordinary process parameters including, but not limited to, size of the coated substrate and coating thickness to be cured, curing initiator, coating composition, presence of additives (e.g. particulate fillers, etc) which modify UV curing, wave energy of the curing lamps as well as their size and number, etc. Applicants’ specification and claims are entirely absent as to these critical aspects, and their lack of context simply fails to provide patentable significance to the specific UV process conditions as claimed. Therefore, given the process criteria disclosed by the prior art, it must be the Examiner’s position that Applicants time and temperature limitations are merely optimization by routine experimentation, which would not patentably distinguish over the prior art since they do not represent a patentable demarcation over the prior art. When a reference discloses the limitations of a claim except for a property, and the Examiner cannot determine if the reference inherently possesses that property (in this case, slip resistance), the burden is shifted to Applicant/s, *In re Fitzgerald* 205 USPQ 594 and MPEP 2112. Further Colton et al teaches in [0067] that their composition does not contain any regulated or environmentally harmful solvent, providing yet further motivation to use the compositions of Colton in the overall process cited above.

The prior art appears to print patterns in plural steps; Applicants’ amended claims cite printing the pattern “in a single step” (the specification states they can be printed in “one or more discrete

stages"). Nonetheless, the printing of an image or design in one step where it is cited in the prior art in sequential steps as in the multicolor images of Schafer does not impart patentability. There is no innovation involved in the broad concept of performing simultaneously operations previously performed in multiple sequential operations, *In re Tatincloux* 108 USPQ 125. See also MPEP 2144.04 V E.

Coloration of applied markings may be multi-color (page 10, top, of Schafer), the coloration of the lines being merely an obvious variation to supply image contrast and/ or decorative effects. Matters related to the choice of ornamentation producing no mechanical effect or advantage considered to constitute the invention are considered obvious and do not impart patentability, *In re Seid* 73 USPQ 431, per claims 10-11.

Per article claims 8-12, the product of the prior art would have been a measuring device/ ruler with cured UV inks including transparent lacquers (clm 9) formed by screen printing, the ink comprising sand, pumice, etc (clm 12) to form single or multi-color lines (clm 10-11).

Per claim 13, it is apparent the forming of any multi-coated ruler requires at least one discrete stage of forming, thereby meeting that limitation of claim 13.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the ruler/ device of Schafer using screen printing in one or more steps to form visual gradations and further imparting non-slip characteristics known according to the APA by further substituting or incorporating the specific UV curable coating materials containing fillers of Colton et al to provide the ruler with a wear and slip resistant surface formed by UV curing.

***Response to Arguments***

Applicant's arguments have been considered.

The Applicants assert the limitation of printing the pattern "in a single step" is not cited in the prior art. Applicants arguments, however, fail to explain HOW the single printing step PATENTABLY DISTINGUSIGHES over the totality of the cited prior art. The Examiner has taken the position, based upon case law, that performing a single step where the prior art performs the same operation in sequential steps is unpatentable. See *In re Tatincloux* 108 USPQ 125. See also MPEP 2144.04 V E. Further, the Examiner takes the position that a single step versus plural steps is simply an obvious variation, with results in an apparent and predictable outcome. Thus Applicants amendment fails to overcome the prior art.

Applicants have challenged the Examiner's succinct and clearly articulated rejection by individually attacking references where the references are combined to demonstrate obviousness. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicants argument regarding the intended use in the preamble is unconvincing because the limitation is merely intended use and bears no patentable weight, the ruler of the prior art being equally useful for the same intended uses. MPEP 2111.02.

Applicants argue the prior art fails to use of a UV ink in printing the indicia on the ruler. However, 1) Schafer teaches on the top of page 3 that image forming on ruler should include "use of a UV-cured (sic) ink", and 2) Colton is introduced as a specific UV curable ink with

utility on the same substrates as those from which ruler blanks are made. The use of UV inks comprising a granular filler (pumice, sand, etc disclosed by the APA) and their curing by UV is therefore simply an obvious step with a predictable outcome, given the totality of the prior art cited in the rejection.

Applicants arguments regarding the two step process of Colton is not persuasive because the APA expressly teaches an ink containing the abrasive filler therein, for fabric contacting surfaces such that the skilled artisan forming rulers for such a purpose would have used this guidance in developing an ink composition for application to ruler blanks. Applicants steps are simply a combination of steps known in the prior art, as articulated by the rejections, and which result in obvious and predictable outcomes.

Arguments directed to dependant claims are basically repeats of those of the independent claims previously discussed and not found to be persuasive. Thus, reiteration of those responses are incorporated herein rather than their being repeated, for the sake of brevity.

3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frederick J. Parker whose telephone number is 571/ 272-1426. The examiner can normally be reached on Mon-Thur. 6:15am -3:45pm, and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571/272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Frederick J. Parker  
Primary Examiner  
Art Unit 1792

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Primary Examiner, Art Unit 1792